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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/058,722	04/10/98	DEVFOKA	I DEVFOKA700.0

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MM51/0222

EXAMINER	
DANIEL S. T	
ART UNIT	PAPER NUMBER
2837	

DATE MAILED:

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**Please find below a communication from the EXAMINER in charge of this application.****Commissioner of Patents**

## Office Action Summary

Application No. 09/058,722	Applicant(s) Devecka
Examiner Jeff Donels	Group Art Unit 2837

Responsive to communication(s) filed on \_\_\_\_\_

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 37-60 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 37-48 is/are allowed.

Claim(s) 49-55 and 58-60 is/are rejected.

Claim(s) 56 and 57 is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

Claims 49-52, 58-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 fails to point out and distinctly claim Applicant's invention, as the method step of "inserting a predetermined amount of money" is a method step performed by the user, not the device. In order to be consistent, Applicant is directed towards parent U.S. Patent 5,739,457, "determining that a predetermined amount of money ..." Correction is required.

Claims 58 and 59 fail to point out and distinctly claim Applicant's invention, as there are no limits, either taught or recited, which determine what is meant by the subjective term "suitably small." Correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 49-55,58,59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-20,23-26,33,33, respectively, of prior U.S. Patent No. 5,739,457. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

In Claim 49, the step of “inserting a predetermined amount of money” is functionally equivalent, to the extent understood, of “determining ....” ('457, Claim 18, line 3).

In Claims 58 and 59, the recitation of “a suitably small footprint,” to the extent understood, is not sufficiently limiting.

Claims 37-48 are allowed.

Claims 56,57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 60 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the attached Notice of References Cited was cited in the parent application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Donels whose telephone number is (703) 308-3115. The examiner can normally be reached on Monday - Thursday from 8:30 AM - 6:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Shoop, can be reached on (703) 308-3103. The fax number for this Technology Center is (703) 305-3431.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-1782.

  
JWD

February 15, 1999

  
JEFF DONELS  
PATENT EXAMINER  
TECH CENTER 2800